

REMARKS

The invention provides for, *inter alia*, compositions of benzoylisoxazoles and/or dione herbicides in combination with antidotes and the method of using said combinations to reduce crop injury arising from the phytotoxicity of the herbicides, especially in maize.

The Examiner is thanked for the indication that the elected species has been expanded to include any safener in combination with the elected herbicide, isoxaflutole, or carboxylate derivatives thereof.

Pursuant to the provisions of 37 C.F.R. §§ 1.17(a) and 1.136(a), Applicants petition the Assistant Commissioner to extend the time period for Applicants to respond to the outstanding Office Action by three (3) months, i.e., up to and including November 12, 2004. A check for \$980.00 is enclosed with this paper to cover the cost of the time extension. Additionally, Applicants enclose a check for \$612 to cover the cost of adding 34 claims in excess of 20 and \$352 to cover the cost of adding 4 independent claims in excess of 3. Applicants authorize the Director to charge any additional fee for consideration of this paper, or credit any overpayment, to Deposit Account No. 50-0320.

Claims 23-41 and 58-92 are pending in this application. In order to advance prosecution and to achieve a reasonable compromise with the Examiner, Applicants cancel claims 1-22 and 42 to 57 without prejudice, admission, surrender of subject matter or intention of creating estoppel as to equivalents. Claim 23 is amended in order to correct clerical errors and thus these amendments add no new matter. The newly added claims 58 and 59 find support in cancelled claims 43 and 44 and throughout the specification. Claims 70-90 are added to specify

application rate of the instant herbicide/antidote combinations in maize crop. These claims find support in the cancelled claims 11-13 and throughout the specification. Finally, in view of the Examiner's helpful comments, Applicants copy claims 1-12 (newly added claims 58-69) from Ruegg et al. (U.S. 6, 489,267). Applicants reserve the right to pursue the cancelled subject matter in a divisional application.

Applicants note that the Examiner had made the Restriction Requirement final. Applicants respectfully disagree with respect to diketonitrile compounds and request reconsideration and withdrawal of the requirement for restriction in view of the following remarks.

MPEP §806.04 and §808.01 state that inventions are unrelated if it can be shown that they are not disclosed as capable of use together and if they have different modes of operation, different functions and different effects. Against this background, Applicants respectfully point out that claim 29 is directed to the diketonitrile compounds which are functionally related to the elected isoxazole compounds (I) since they are herbicidal metabolites of the isoxazoles (see references at page 1 of the specification). Thus, Applicants believe that application of diketonitrile compounds of claim 29 to crops should result in similar herbicidal effects to the weeds as the application of the elected isoxazole compounds (I). Accordingly, Applicants urge that the instantly examined claims and claim 29 represent a web of knowledge and continuity of effort that merits examination in a single application. Thus, reconsideration and modification of the Restriction Requirement are warranted.

Claims 15, 18, and 19 are rejected under 35 U.S.C.112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter

which Applicant regards as the invention. In view of the cancellation of these claims, Applicants urge that the rejection is moot and should be withdrawn.

Claims 20-22 are objected under 37 CFR 1.75 as being allegedly a substantial duplicate of claims 1, 15, and 18. In view of the cancellation of these claims, Applicants urge that the objection is moot and should be withdrawn.

Claims 1-3, 7-9, 11-28, 36-44, 47, 48, and 51-57 under 35 U.S.C. 135(a) as being based upon claims 1-12 of U.S. Patent No. 6, 489,267 to Ruegg et al ("Ruegg"). Applicants would like to respectfully remind the Examiner that the instant application has earlier priority date than Ruegg, and that the certified copies of U.K. Patent No. 6, 489,267, from which the instant application claims priority, was forwarded to the USPTO on February 13, 2004. Further, in view of the Examiner's suggestions, Applicants copied claims 1-12 (newly added claims 58-69) from Ruegg.

Claims 1-3, 7, 9, 15, 18, 20-22, 42, 47 and 48 are rejected under 35 U.S.C. 102(a) and (e) as being allegedly anticipated by Forget (U.S. 5,905,057, "Forget") and Penner (U.S. 6,235,682, "Penner"). In view of the cancellation of claims 1-22 and 42-57, Forget and Penner do not teach instantly claimed combination of isoxazole herbicides (I) with safeners and thus these references cannot anticipate the present claims. Thus, the rejection under 35 U.S.C. 102(a) and (e) is moot and should be withdrawn. Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 1-3, 7-9, 11-25, 36, 42-44, 47, 48, 51-57 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over the combined teachings of Forget and Penner. Since Forget

and Penner, taken alone or in any fair combination do not suggest the inventive combinations of isoxazole(I) with safeners, the instant method of use of these combinations and finally unexpectedly high phytotoxicity against weeds which results from the application of these combinations, Applicants urge that the rejection does not establish a *prima facie* case of obviousness and should be removed.

The Office Action states that "...these patents both teach that isoxaflutole and related carboxylate ester derivatives thereof may be combined with safening agents for application to crops". Id. (Office Action at page 5). Applicants respectfully point out that in view of the cancellation of claims 1-22 and 42-57, Forget and Penner do not teach instantly claimed combinations of isoxazole herbicide (I) with safeners, and the instantly claimed of reducing phytotoxicity to a crop, especially maize.

Additionally, Applicants urge that that Penner and Forget do not teach the instantly claimed method of reducing phytotoxicity to a crop, especially maize, by application of instant herbicidal combinations. For example, Forget and Penner fail to teach the particular benefit of the method where the safener is applied to the plants or plant seeds before the application of the herbicide. Moreover, Forget teaches a particular formulation aid for isoxazole herbicides rather than a particular herbicide-safener combination. Finally, Penner also deals with a preferred repellent adjuvant which provides a protection for the foliage of crop plants. Although some compositions applied comprise benoxacor as safener, most safeners taught in Penner are used as a conventional safener for metolachlor (see Penner page 4, lines 6 to 16). Thus, Penner fails to teach the use of safeners for the isoxazole herbicides. Accordingly, Penner and Forget do not suggest the inventive combinations of isoxazole(I) with safeners and the instant method of use of

these combinations, and thus Applicants urge that the rejection does not establish a *prima facie* case of obviousness

However, even if it were held that combined teachings of Forget and Penner establish a *prima facie case* of obviousness, a point Applicants do not concede, Applicants respectfully point out that combinations of herbicides and safeners according to the invention cause significantly reduced damage or no damage to the maize, and when compared to the damage caused by these herbicides when they are applied to the crops, such as maize, without safeners (see Example 1).

The present invention relates to the technical field of the crop protection products, in particular herbicide/antidote combinations, which are outstandingly suitable for the use against competing harmful plants in crops of useful plants. Because the mechanism by which safeners reduce the harmful effects of a herbicide is unknown, the art recognizes that it is difficult to select *a priori* a particular safener for a particular class of herbicides. Applicants' discovery that the combination of a particular class of herbicides in combination with particular safeners resulted in unexpectedly high phytotoxicity effect against weeds while protecting crops, such as maize, could not be predicted.

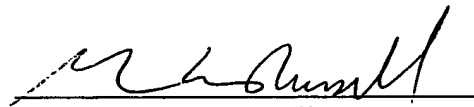
Thus, Applicants urge that the rejection does not establish a *prima facie* case of obviousness and should be removed.

Accordingly, in view of the foregoing, reconsideration of all rejections in this application is requested and favorable action is solicited.

Respectfully submitted,

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By:

A handwritten signature in black ink, appearing to read 'Mark W. Russell', is written over a horizontal line.

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